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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,551	02/09/2004	Ken Furukuwa	81716.0120	1137

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EXAMINER

NORRIS, JEREMY C

ART UNIT	PAPER NUMBER
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2841

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/774,551

Applicant(s)

FURUKUWA, KEN

Examiner

Jeremy C. Norris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-11 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-11 and 16-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/223,973.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5 April 2006 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,229,549 (Yamakawa).

Yamakawa discloses, referring primarily to figure 6, a ceramic circuit board comprising; a ceramic substrate (1) having a through hole (2); a metal column (7) arranged within the through hole; and metal circuit plates (5, 6) attached to both surfaces of the ceramic substrate in such a way as to stop up the through hole (, wherein the metal circuit plates attached to both surfaces of the ceramic substrate are connected to each other by the metal column, and wherein, between an inner wall surface of the through hole and an outer wall surface of the metal column is secured a space defining a cavity, wherein the cavity is free from material (col. 2, lines 30-35)

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[claim 9], wherein the space exists along the entire length of the metal column [claim 16].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamakawa in view of US 4,816,323 (Inoue).

Regarding claims 10 and 11, Yamakawa discloses the claimed invention as described above except Yamakawa does not specifically state that the metal circuit plate [claim 10] or the metal column [claim 11] are made of copper or aluminum. However, it is well known in the art to form conductive elements of copper as evidenced by Inoue (col. 3, lines 55-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to use copper for the conductive plate and column in the invention of Yamakawa. The motivation for doing so would have been to

use a relatively inexpensive highly conductive material. Moreover, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamakawa.

Regarding claim 17, Yamakawa discloses the claimed invention except Yamakawa does not specifically state that the distance between the inner wall surface of the through hole and the outer wall surface of the metal column is in a range of 30 to 200 μm [claim 17]. However, such a modification would simply involve a change in size, which is well known to the ordinary artisan. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to form the gap to be in a range of 30 to 200 μm as is known in the art. The motivation for doing so would have been to have a sufficient gap without compromising the thickness needed for signal transmission. Furthermore, it has been held that more than a mere change of form is necessary for patentability. *Span-Deck, Inc v. Fab-con, Inc.* (CA 8, 1982) 215 USPQ 835. Moreover, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering that optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Similarly, regarding claim 21, Yamakawa does not specifically disclose that the metal column has a diameter of 200 μm or more [claim 21]. However, such a modification would simply involve a change in size, which is well known to the ordinary

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artisan. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to form the column to be 200 μm or more as is known in the art. The motivation for doing so would have been to have a sufficient thickness needed for signal transmission. Furthermore, it has been held that more than a mere change of form is necessary for patentability. *Span-Deck, Inc v. Fab-con, Inc.* (CA 8, 1982) 215 USPQ 835. Moreover, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering that optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claim 18, Yamakawa discloses all the features of the claimed invention as applied to claim 9 above, but does not disclose the circuit plate has its surface plated with a layer made of nickel. However, nickel plating is well known in art for increasing the adhesiveness of the circuit plate to avoid the problem of peeling. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to provide nickel plating to the circuit plate of Yamakawa, in order to improve the adhesiveness to avoid peeling.

Regarding claim 19, Yamakawa discloses all the features of the claimed invention as applied to claim 18 above, but does not disclose the plate layer made of nickel-phosphorous alloy containing phosphorous in an amount of 8 to 15 wt%, as claimed in claim 19. However, the claimed material is known in the art to be used in the circuit board. Further, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ. Therefore, it would have been

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obvious to a person of ordinary skill in the art at the time of applicant's invention to provide the circuit board of Yamakawa with the plate layer made of the material as claimed as it is known in the art

Regarding claim 20, Yamakawa does not specifically disclose that the plate layer is 1.5 to 3 μm thick [claim 20]. However, such a modification would simply involve a change in size, which is well known to the ordinary artisan. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to form the plate layer to be 1.5 - 3 μm as is known in the art. The motivation for doing so would have been to have a sufficient thickness for protection without needlessly increasing the overall height of the device. Furthermore, it has been held that more than a mere change of form is necessary for patentability. *Span-Deck, Inc v. Fab-con, Inc.* (CA 8, 1982) 215 USPQ 835. Moreover, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering that optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Response to Arguments

Applicant's arguments with respect to claims 9-11 and 16-21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy C. Norris whose telephone number is 571-272-1932. The examiner can normally be reached on Monday - Friday, 9:30 am - 5:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on 571-272-1957. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JCSN


Jeremy C. Norris
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